



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,313	11/19/2001	Halg	01- 1701	7362
20306	7590	09/28/2006	EXAMINER	
MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP			GORDON, BRIAN R	
300 S. WACKER DRIVE			ART UNIT	
32ND FLOOR			PAPER NUMBER	
CHICAGO, IL 60606			1743	

DATE MAILED: 09/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/992,313

Applicant(s)

HALG,

Examiner

Brian R. Gordon

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 7-10-06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 48-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 48-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. In view of the cancellation of all previous pending claims the previous rejections directed thereto are hereby withdrawn.

Applicant has added all new claims 48-71. Applicant has not specifically indicated where each of the claims are supported in the specification, but has generally stated they are supported throughout the specification. Due to the lack of specifically providing where each limitation is supported the examiner hereby assumes the material is new matter.

An extensive amount of the claims are directed to or include a specific reference to "polydentate chromogenic ligands". The original specification did not previously recite nor define the term therein. The examiner has found close references to the term in only two locations in the original claims 24 and 25. As such the specification is considered to absent of including material which is claimed. In view of such, it appears as if the specification is absent of describing the method claimed directed to the steps which specify the term "polydentate chromogenic ligands". As such the claims are considered new matter. If applicant believes the examiner is error, applicant is hereby required to give specific locations within the original specification where each of the method steps of the new claims are supported therein.

As to applicant's arguments directed to the previous rejections, it should be noted all of the previous pending claims have been cancelled. However in reference to the submission of the declaration by Dr. Halg, it should be noted the arguments included

within the declaration were addressed in the previous Office Action at item #6, pages 4-5. The declaration does not contain nor reference any data to exhibit any unexpected results. The declaration only includes opinionated comments by, the inventor, Dr. Halg that mirror the arguments of the inventors representative that are directed to the rejection of claims based upon Lung et al. in view of Bauer et al. It should be noted opinions or arguments submitted by the inventor do not hold any more distinguishing weight as those submitted by applicant's representative.

It should be noted that the motivation to combine references is not required to be directed to solve the same problems or achieve the same goals as that desired by applicant. Furthermore it is not required that references disclose the same advantages or disadvantages listed by applicant.

As previously stated, the primary reference of Lung et al. discloses the invention as claimed except for the employment of the specific ligands. Bauer et al. discloses the use of the specific ligands employed as label as well. The motivation to substituted the label of Lung et al. with that as taught by Bauer et al. al can be for a purpose (see rejection for specific reasoning) different from that which applicant chose to employ the use of the ligand. The fact remains the use of such a ligand as a label was known prior to applicant's invention.

In view of such, the examiner agrees the position of the prior examiner and asserts the previous rejection of the prior Office Action was correct.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

Art Unit: 1743

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 48-71 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims have been amended to include new matter as specified above (see Response to Arguments).

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 48-63 and 66-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,061,639 to Lung et al in view of US Patent 5,320,969 to Bauer et al.

Lung et al disclose a method for determine the volume of liquid in a container. The method involves providing a first well having a known volume or colorimetric reagent of a known concentration. A volume of the colorimetric reagent is dispensed into a second well. In other words, a portion of the colorimetric reagent is separated from the first well and introduced into a second well. The absorbance of the reagent in each well is measured and the actual volume of the separated portion of the colorimetric reagent is calculated by correlating the known volume and concentration with the absorbance of the separated portion. See col. 3, lines 14-29. Lung et al further

Art Unit: 1743

disclose adding a diluent to the colorimetric reagent to maintain the stability of the reagent (col. 4, lines 39-40). The colorimetric reagent disclosed by Lung et al comprises cobalt sulfate or potassium dichromate.

Lung et al differs from the instantly claimed invention in that Lung et al use a different colorimetric reagent than the chromophoric indicator and metal ion complex used in the instant invention.

Bauer et al teach a reagent composition comprising a complex formed from a polyvalent metal ion having a valence of at least two and an indicator capable of interacting with the metal ion to provide a polyvalent metal ion-indicator complex (col. 4, lines 50-58). As the polyvalent metal ion, Bauer et al teach using ferric and ferrous ions (col. 11, lines 41-50). As indicators, Bauer et al teach using bathophenanthroline, among others (col. 12, line 54 - col. 13, line 13). Bauer et al teach that the polyvalent metal ion-indicator complex has an advantage of undergoing a color transition that does not involve competing chemical or physical interaction, such as pH change or interactions with other components of a test sample (col. 4, line 68 - col. 5, line 3). It would have been obvious to one of ordinary skill in the art to substitute the colorimetric reagent of Lung et al for the polyvalent metal ion-indicator complex of Bauer et al to provide a reagent resulting in enhanced color transition independent of the sample condition (i.e. pH) and without interfering with other substances in the sample.

Lung et al also differs from the instant invention in that there is no disclosure of the sequence in which the reagents are added. Lung et al disclose adding the colorimetric reagent to the diluent and measuring the absorbance. There is no

disclosure of, for example, adding the reagent to the residue, as opposed to the separated portion or adding the sample to a container already having the reagent. The sequence of the addition of reagents does not appear to have an effect on the method of determine the volume of a liquid itself. In the absence of new or unexpected results, the selection of any order of mixing ingredients or performing process steps has been held to be prima facie obviousness.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian R. Gordon whose telephone number is 571-272-1258. The examiner can normally be reached on M-F, with 2nd and 4th F off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


brg